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09/930,668	08/15/2001	Judith Edmonds Starkey	54679-400100	3237
27717	7590	12/12/2007	EXAMINER	
SEYFARTH SHAW LLP			PORTER, RACHEL L	
131 S. DEARBORN ST., SUITE2400			ART UNIT	
CHICAGO, IL 60603-5803			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/930,668

Applicant(s)

STARKEY ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the amendments filed 1/11/07 and 5/2/07.

Claims 1-30 are pending.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

4. Claim 22 is objected to because of the following informalities: the present claim recites "to the first and second assistance program that is identified". The examiner

respectfully submits that "program" should be "programs" and "is" should be "are."

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, 9-13, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Indicare™- On-line Patient Assistance Program Website Users Manual." (referred to hereinafter as Indicare) in view of Pritchard (US 4,491,725)

[claim 1] Indicare discloses a method for identifying and applying for benefits for a patient comprising:

- obtaining initial patient information (i.e. application/enrollment forms (page 3, 7-10; 15-16).
- based upon initial patient information, making an initial determination as to whether it is likely that the benefits can be obtained (pg. 12, step 7)
- if the initial determination is that benefits are likely to be obtained, obtaining additional patient information, (page 17—indicates whether pharmaceutical company is likely to decline/ require additional information.)

- providing a second indication that benefits are likely and submitting the application to the assistance program (page 14-15, 17—i.e. acceptance or denial of a claim)

Claim 1 has been amended to further recite “receiving a referral from a medical facility for a patient” and rejecting the referral if the initial determination is that it is unlikely that benefits will be obtained.

Indicare discloses receiving patient information for a benefit program, but does not expressly disclose the steps of receiving a referral from a medical facility for a patient” and rejecting the referral if the initial determination is that it is unlikely that benefits will be obtained. Pritchard discloses a method further comprising receiving a referral from a medical facility for a patient and rejecting the referral if the initial determination is that it is unlikely that benefits will be obtained. (col. 4, lines 30-42; 65-col. 5, line 3; col. 7, lines 7-36—likely or unlikely to receive benefits). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Indicare with the teaching of Pritchard to provide an indication of whether or not benefits will be received. As suggested by Pritchard, one would have been motivated to include these features to minimize the hardship to patients by reducing the likelihood that they will have to pay full service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

[claims 2-6] Indicare gathers information regarding the patient's age and medical condition; income and financial resources. (page 15, Questionnaire) The patient

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information is compared to well-established criteria (e.g. agency criteria) (page 17—  
Pharmaceutical company programs)

[claims 9-10] Indicare discloses a system/ method wherein additional patient  
information includes a discharge diagnosis (page 17-questionnaire). Indicare further  
discloses providing prompts to assist in the completion of an application (page 12  
“patient data” and “physician data” section on screen shots)

[claim 11] Indicare discloses determining whether the patient is covered by an  
assistance program. (page 17 questionnaire—asks patient if they have health  
insurance)

[claim 12] Indicare discloses determining whether the patient is previously in the  
system with a claim/application for assistance. (page 13—allows users to start with old  
claim/application information.

[claim 13] Indicare discloses a method for accepting a referral for a patient, comprising  
the steps of:

- receiving a patient referral, the patient referral including initial patient  
information, (physician letters requesting assistance from the pharmaceutical  
company (i.e. donator) on behalf of the patient. (pages 3,5-6)
- determining whether to accept the patient referral by:

- comparing the initial patient information to a well-established criteria associated with an assistance program; (pg. 12, step 7)
- if the comparison indicates that the initial patient information satisfies the well-established criteria, then accepting the patient referral; (page17—indicates whether pharmaceutical company is likely to decline/ require additional information.)
- if the patient referral is accepted, then obtaining additional patient information; (page17—indicates whether pharmaceutical company is likely to decline/ require additional information.)

Claim 13 has been amended to further recite the assistance program is for “Medicaid” and

- comparing the initial patient information and the additional patient information to eligibility requirements for the assistance program; and
- if the comparison indicates it is likely that benefits can be obtained under the Medicaid assistance program, then providing an application for the Medicaid assistance program. (page 14-15,17—i.e. acceptance or denial of a claim)

Indicare discloses receiving patient information for a benefit assistance program, but does not expressly disclose comparing information and eligibility requirements for the Medicare Program. Pritchard discloses a method further performing comparisons and assessing benefit eligibility for Medicare and Medicaid. (col. 4, lines 30-42; 65-col. 5, line 3; col. 7, lines 7-63). Pritchard also discloses that application/claim forms are

provided to claim the benefits. (col. 7, lines 37-50) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Indicare with the teaching of Pritchard to provide an indication of whether or not benefits will be received. As suggested by Pritchard, one would have been motivated to include these features to minimize the hardship to patients (e.g. low income and elderly patients) by reducing the likelihood that they will have to pay full service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

[claim 17] Indicare further discloses providing prompts to assist in the completion of an application (page 12 "patient data" and "physician data" section on screen shots)

[claim 18] Indicare discloses automatically completing a section of the application using the initial patient information. (pages 13-14)

[claims 19-21] Indicare discloses a method wherein the patient referral is received and accepted by a pharmaceutical company (i.e. an entity independent of the medical provider providing patient treatment)(page 17). Indicare further discloses that medical providers still cover some of the cost to accepted participants (page 3, last paragraph). Indicare further discloses submitting and monitoring the application to the assistance program (page 14-15,17—i.e. acceptance or denial of a claim)

7. Claims 7-8, 14-16, and 22- 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Indicare™- On-line Patient Assistance Program Website Users Manual" and Pritchard in view of DeTore et al (USPN 4,975,840).

[claims 7-8] Indicare discloses the method/system of claim 1 as explained in the rejection of claim 1, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claims 14-16] Indicare discloses the method/system of claim 13 as explained in the rejection of claim 13, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claim 22,26] Indicare discloses a method for identifying and applying for benefits for a patient comprising the steps of :

- obtaining initial patient information (i.e. application/enrollment forms (page 3, 7-10; 15-16).
- based upon initial patient information, making an initial determination as to whether it is likely that the benefits can be obtained (pg. 12, step 7) by comparing initial patient information to well-established criteria (page 17—Pharmaceutical company programs)
- if the initial determination is that benefits are likely to be obtained, obtaining additional patient information, (page 17—indicates whether pharmaceutical company is likely to decline/ require additional information.)
- providing a second indication that benefits are likely and selecting the identified the assistance program (page 14-15, 17—i.e. acceptance or denial of a claim)

Claim 22 has been amended to recite “making a subsequent determination as to whether it is likely that benefits can be obtained for the patient by comparing the initial patient information and the additional patient information to the first and second assistance program[s] that [are] identified.” Indicare discloses the features of claim as explained above, but does not expressly disclose making a subsequent determination as to whether it is likely that benefits can be obtained for the patient by comparing the

initial patient information and the additional patient information to the first and second assistance program[s] that [are] identified.

Pritchard discloses a method further comprising making a subsequent determination as to whether it is likely that benefits can be obtained for the patient by comparing the initial patient information and the additional patient information to the first and second assistance program[s] that [are] identified. (col. 5, lines 40-65; col. 7, line 7-37; col. 8, lines 30-43—reviews secondary and tertiary insurance coverage qualifications, Medicare/Medicaid qualifications. ) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Indicare with the teaching of Pritchard to provide an indication of whether or not benefits will be received. As suggested by Pritchard, one would have been motivated to include these features to minimize the hardship to patients (e.g. low income and elderly patients) by reducing the likelihood that they will have to pay full service fees, while not shifting the burden to healthcare providers. (col. 2, lines 15-25)

Indicare discloses the method/system of claim 22 as explained above, but does not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare and Pritchard in combination with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one

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would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

[claim 23] Indicare further discloses providing prompts to assist in the completion of an application (page 12 "patient data" and "physician data" section on screen shots)

[claims 24-25] Indicare gathers information regarding the patient's age and medical condition; income and financial resources. (page 15, Questionnaire). The patient information is compared to well-established criteria (e.g. agency criteria) (page 17—Pharmaceutical company programs)

[claim 27-28] Indicare and Pritchard disclose the method/system of claim 22, but do not expressly disclose examining probability models. However, DeTore discloses that it is well known in the insurance arts to examine probability models for policy (e.g. assistance programs) acceptance. DeTore further discloses that the probability models used are based upon prior experience in obtaining similar coverage (i.e. benefits under the second assistance program) (col. 18, lines 23-32) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system and method of Indicare with the teaching DeTore to compare patient information to probability models. As suggested by DeTore, one would have been motivated to include this feature to assist the program in avoiding excessive financial losses (col. 18, lines 23-63)

8. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Indicare™- On-line Patient Assistance Program Website Users Manual," and Pritchard, and in further view of Official Notice.

[claims 29-30] Indicare and Pritchard disclose the method of claim 13 as explained in the rejection of claim 13, but do not expressly disclose that the Medicaid assistance program is for disability or includes analysis of indigence status. However, it is well known that indigence/income and disability are eligibility criteria for Medicaid. At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to review the elements for applicant. One would have been motivated to include this feature to comply with state and federal standards and regulations.

### ***Response to Arguments***

9. Applicant's arguments with respect to claim 1, 7, and 22 have been considered but are moot in view of the new ground(s) of rejection.

The examiner has provided an additional reference and citations to address applicants arguments regarding the newly added features.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

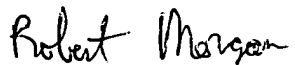
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
RP

  
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